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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,190	01/16/2007	Siegfried Thomalla	HM-726PCT	4058

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NEW YORK, NY 10017

EXAMINER

GISSEL, GUNNAR J

ART UNIT	PAPER NUMBER
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2856

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/577,190	Applicant(s) THOMALLA ET AL.	
	Examiner Gunnar J. Gissel	Art Unit 2856	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 April 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>04/25/2006</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: reference numeral 9 is not in the description. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

1. Claims 1, 2, 4, and 5 are objected to because of the following informalities: The reference characters are not enclosed within parentheses, which could cause confusion with other numbers. Claim 4 recites "as anintended value," which appears to mean "as an intended value." Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. It is unclear what units "2-3 per thousand" are in, and what units the "per thousand part" refers to. The specification duplicates the phrasing of the claim, so no explanation of the units or type of enlargement is present.

5. Claim 5 provides for the use of the method of Claim 1, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 5 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

6. Claim 1 recites the limitation "the water volume" in line 6. There is insufficient antecedent basis for this limitation in the claim.

7. Claim 1 recites the limitation "the pressure test according to DIN EN 10208 part 2" in lines 6-7. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 2,667,136 to R. M. Reichl et al. (Reichl).

Regarding Claim 1, Reichl discloses a method for adjusting specific quality characteristics and/or properties of pipes by means of pressure testing, particularly steel pipes for pipelines for combustible media, wherein an additional water volume (Reichl, column 4, lines 73-75; column 5, lines 6-7) is filled into each individual pipe 1 in addition to the water volume for the pressure test according to DIN EN 10208 part 2, with the requirement that the pipe material is loaded slightly in the plastic range (Reichl, column 5, lines 39-42). The water is filled past the amount required for the pressure test, thus implying a water volume for the pressure test and an additional water volume.

Regarding Claim 2, Reichl discloses the additional water volume 11 remains in the pipe for a period of 2 to 3 min (Reichl, column 5, lines 6-7).

Regarding Claim 3, Reichl discloses the pipe is enlarged at the outer diameter by 2 to 3 per thousand (Reichl, column 1, lines 6-10).

Regarding Claim 4, Reichl discloses the additional water volume ii which is taken into consideration as an intended value is determined by filling in a step by step manner

an additional water volume 11 into a test pipe 1 until the changes reach a previously determined limit value (Reichl, column 5, lines 39-42).

Regarding Claim 5, Reichl discloses use of the method in spirally welded pipes 1 (Reichl, column 1, lines 4-10). Tubes, in this context, and in the industry generally, are often interchangeable with pipes. A tube is sometimes defined as a pipe with thin walls, or as a hollow body measured from the inside diameter, as opposed to the outside diameter as a pipe. In this case, Reichl's invention does not differentiate between tubes or pipes, and in any case, it is known to anyone skilled in the art of pressure testing and pipefitting that all pipes respond to pressure in the same manner; the failure modes may differ, but a pipe or tube (regardless of straight seam, sectional, spiral or seamless) is pressure tested in a similar, or the same, manner.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent 6,601,423 regards a device that uses water pressure to shape out-of-round tubing. US Patent 1,870,009 regards water pressure in pipes. US Patent 5,953,945 concerns a hydroforming device. US Patent 5,927,119 concerns a hydroforming device. US Patent 5,737,953 concerns a method of stretching hollow bodies with water pressure. US Patent 5,303,570 concerns a method for hydrostatically deforming a hollow body. US Patent 3,303,680 concerns a method for forming fittings.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gunnar J. Gissel whose telephone number is (571)274-3411. The examiner can normally be reached on Mon-Fri, 7:30AM-5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron Williams can be reached on (571)272-2208. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/GJG/

6/16/2008
/Hezron Williams/
Supervisory Patent Examiner, Art Unit 2856